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HAMILTON, BROOK, SMITH & REYNOLDS, P.C.  
530 VIRGINIA ROAD  
P.O. BOX 9133  
CONCORD, MA 01742-9133

EXAMINER

NI, SUHAN

ART UNIT

PAPER NUMBER

2643

DATE MAILED: 07/30/2003

AA

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/524,501	LEEDOM ET AL. 
	<b>Examiner</b>	<b>Art Unit</b>
	Suhan Ni	2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 12 May 2003.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-68 is/are pending in the application.  
4a) Of the above claim(s) 9-19, 29 and 31-68 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-8, 20-28, 30 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)      4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)      5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5-8 .      6)  Other: \_\_\_\_\_ .

**DETAILED ACTION**

1. This communication is responsive to the reply to restriction requirement for election of Group I, claims 1-8, 20-28 and 30, filed 05/12/2003.
2. This application contains claims 9-19, 29 and 31-68 drawn to an invention nonelected with traverse in the application. A complete reply to a future final office action must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R.1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-8, 20-28 and 30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,473,511. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-14 of U.S. Patent No. 6,473,511 are similar in scope to claim 1-8, 20-28 and 30 of the US patent application 09/524,501 with obvious wording variations.

#### *Claim Objections*

4. Claim 14 is objected to because of the following informalities:

...

Appropriate correction is required.

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 1-8 and 20-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There are numerous of indefinite limitations in the claims, and the examples are:

In claim 1, it recites the limitation "the aperture" in line 3. There is insufficient antecedent basis for this limitation in the claim.

In claim 1, it recites the limitation “the first bend” in line 3. There is insufficient antecedent basis for this limitation in the claim.

...

In claims 7-8, the limitations of “the battery is metal or plastic” are indefinite. Should it be: the battery comprises metal and/or plastic material?

In claim 20, it recites the limitation “the aperture” in line 3. There is insufficient antecedent basis for this limitation in the claim.

In claim 20, it recites the limitation “the first bend” in line 3. There is insufficient antecedent basis for this limitation in the claim.

In claim 21, the term “expandable” (in line 3) is indefinite because the metal shell is usually rigid and not expandable, relatively.

...

Claims 23 and 26-27 fail to further limit a previous claim(s), which is in scope of a battery.

...

Since there are too many indefiniteness limitations in the claims, it would be a burden on the examiner to list them all. Therefore, applicants’ corporation for thoroughly revising the claims would be highly desirable for speeding up the processing of this application.

### ***Drawings***

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “battery including **an elliptical**

“cross-section” in claims and others must be shown or the feature(s) canceled from the claim(s).

No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 1-3, 5, 7-8 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Narisawa (US-5,347,584).

Regarding claims 1-3 and 20, Narisawa discloses a battery (28) for a hearing aid (20), the battery being configured to conform to a portion of an ear canal as claimed (Fig. 4), wherein the battery is inherently includes a tapered and stepped configuration.

Regarding claim 5, Narisawa further discloses the battery, wherein the hearing aid is non-disposable.

Regarding claims 7-8, Narisawa further discloses the battery, wherein the battery inherently comprises metal (for shell) and plastic (for sealer) material as claimed.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Narisawa (US-5,347,584).

Regarding claim 4, Narisawa does not clearly teach that the hearing aid is a disposable type hearing aid as claimed. Since providing a suitable battery for a disposable hearing aid is very well known in the art, it therefore would have been obvious to one having ordinary skill in the art at the time the invention was made to be motivated to provide the battery for a disposable hearing aid, in order to utilize the battery and operate the disposable hearing aid.

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Narisawa (US-5,347,584) in view of Oltman et al. (US-4,343,869).

Regarding claim 6, Narisawa does not clearly teach the battery having an elliptical cross-sectioned configuration as claimed. Oltman et al. disclose a button cell for power up miniature electronics (10), comprising an elliptical cross-sectioned configuration. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to be motivated to provide the battery for the hearing aid, in order to utilize the battery and to reduce the size of the hearing aid.

10. Claims 21-28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oltman et al. (US-4,343,869).

Regarding claims 21-22 and 30, Oltman et al. disclose a button cell or a battery (10), comprising a plastic housing (30) partially surrounding a metal shell (18, 42); a plastic cathode plate (34); and a cathode grid (36) as claimed. But Oltman et al. do not clearly teach that the battery is utilized to power-up a hearing aid as claimed. Since providing a suitable battery, such as a button cell, for a hearing aid is very well known in the art, it therefore would have been obvious to one having ordinary skill in the art at the time the invention was made to be motivated to provide the battery for a suitable hearing aid, in order to utilize the battery and to operate the hearing aid.

Regarding claim 23, Oltman et al. do not clearly teach that the battery is utilized to power-up an insertable hearing aid as claimed. Since providing a suitable battery, such as a button cell, for a hearing aid is very well known in the art, it therefore would have been obvious to one having ordinary skill in the art at the time the invention was made to be motivated to provide the battery for a suitable hearing aid, such as an insertable hearing aid, in order to utilize the battery and to operate the hearing aid.

Regarding claims 24-25 and 28, Oltman et al. further disclose the battery, wherein the plastic housing includes a tapered, stepped and an elliptical cross-sectioned configuration (Fig.).

Regarding claims 26-27, Oltman et al. do not clearly teach that the battery cab be utilized to power-up a hearing aid as claimed. Since providing a suitable battery, such as a button cell, for a disposable/non-disposable hearing aid is very well known in the art, it therefore would have been obvious to one having ordinary skill in the art at the time the invention was made to be motivated to provide the battery for a suitable hearing aid, in order to utilize the battery and to efficiently operate the hearing aid.

## ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Suhan Ni** whose telephone number is (703)-308-9322, and the number for fax machine is (703)-305-9508. The examiner can normally be reached on Monday through Thursday from 9:00 am to 7:30 pm. If it is necessary, the examiner's supervisor, **Curtis Kuntz**, can be reached at (703) 305-4708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 305-3900.

*Suhan Ni*  
SUHAN NI  
PATENT EXAMINER  
Suhan Ni  
Patent Examiner  
Art Unit 2643

July 22, 2003